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DOCKET NO. 2003.10.004.WS0
U.S. SERIAL NO. 10/696,502
PATENTREMARKS

Claims 1-3, 5-8, 10-12 and 14-19 are currently pending and have been rejected.

CLAIM REJECTIONS – 35 U.S.C. § 102

Claims 1-3, 6-8, 11-12 and 14 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,011,971 to Jolma. This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131, p. 2100-67 (8th ed., rev. 5, August 2006) (*citing In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. *Id.* (*citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)).

Independent claims 1, 6, and 11 require that the hard handoff is performed when the mobile station reaches a border for a hard handoff region, the hard handoff region a portion of the second wireless network. This limitation is not taught or suggested by the art of record.

The Examiner indicates, with relation to these limitations, a reliance on Jolma's col.5, lines 35-39 and 50-53:

The cell 41 is served by two overlapping base stations, BTS11 and BTS21. BTS11 is coupled to base station controller BSC1, and BTS21 is coupled to base station controller BSC2. ... The terminal equipment carries out a hard handover from the base station BTS11 to the base station BTS21, and consequently, the base station controller change from BSC1 to BSC2 takes place.

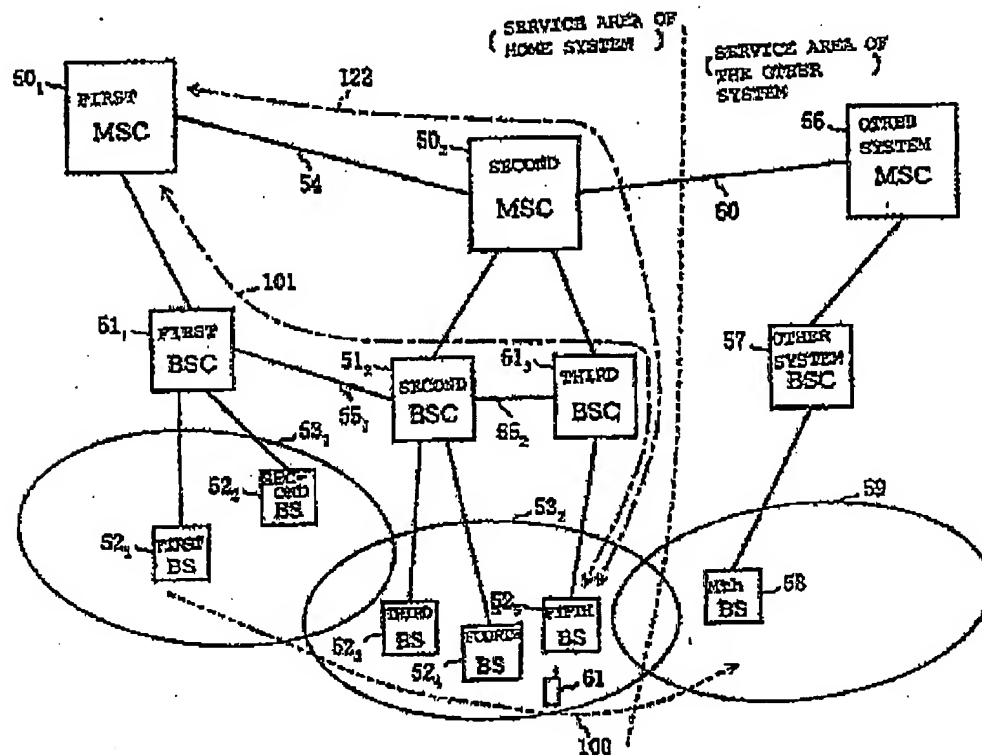
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It is clear that these passages have nothing at all to do with a border of the hard handoff region. Jolma does not define or describe a "hard handoff region", as claimed, or that it is a portion of the second wireless network, or that the hard handoff is performed when it the mobile station reaches a border of the hard handoff region. The Examiner appears to allege that Jolma defines a "hard handoff region", but only gives a cursory reference to Figure 4:

Fig. 4



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Jolma does not describe any part of this figure as a hard handoff region. The Examiner's cursory reference cannot support a *prima facie* anticipation rejection. As there is not suggestion or motivation to modify Jolma to include this feature, there can also be no proper obviousness rejection over Jolma.

The Examiner responds that

...it is an inherent feature, and/or an obvious expedient thereof, that to perform a successful hard handoff for a mobile station between two base transceiver stations in different networks, such mobile station must reach a border of a hard handoff region or must be located in the hard handoff region. Once it is determined that the mobile station is in a hard handoff region, the base station controller decides, among other things, whether the hard handoff should occur, to which base station, and/or when it should occur.

The Examiner's reasoning is partially correct, but misapplied. It is of course true that a hard handoff only occurs when a mobile station is located in a region capable of hard handoffs – that is, a hard handoff can occur when the mobile station is in a place in which it is possible for the hard handoff to occur. This is not the limitation at issue, however.

The limitations of the independent claims describe that the hard handoff happens at a specific time – the hard handoff is performed when the mobile station reaches a border for a hard handoff region, where the hard handoff region is a portion of the second wireless network. This is described in the specification as filed, e.g., at paragraph 050:

[050] As the mobile station 116 moves toward the first wireless network 100, the mobile station 116 may eventually reach the border of the hard handoff region 234, such as at point 290 in the illustrated example. At this point, a hard handoff from the BTS 244 to the

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transition BTS 224 will be performed such that the mobile station 116 will be in communication with the transition BTS 224 through communication link 284. Thus, at point 290, the mobile station 116 may communicate through the base station controller 240 on carrier frequency F2 or through the base station controller 210 on carrier frequency F1.

The limitation, and the function described above, describes that at the point that the mobile station reaches the border of the hard handoff region, the hard handoff is performed. This feature is not taught or suggested by Jolma at all, and so there can be no proper anticipation rejection, particularly since Jolma also does not have a hard handoff region, or teach that it is part of a second network, as claimed.

This feature is also not inherent to a hard handoff, as the Examiner has already noted. A hard handoff may occur at any time that the mobile station is in a location where it is possible to do so, when the system forces such a handoff. It does not necessarily occur at the time that the mobile station reaches the border of a hard handoff region. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In*

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re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted, emphasis added).

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

As the current claims describe a specific conditions under which a hard handoff is made, and this feature is not taught or suggested by any art of record, all claims distinguish over all art of record.

Accordingly, the Applicant respectfully requests the Examiner to withdraw the § 102 rejections with respect to all claims.

CLAIM REJECTIONS -- 35 U.S.C. § 103

Claims 5, 10 and 15-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jolma. The Applicant respectfully traverses the rejection.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142, p. 2100-133 (8th ed. rev. 4, October 2005). Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. *Id.* To establish a *prima facie* case of obviousness, three basic criteria must be met: *Id.* First, there must be some suggestion or motivation, either in the references themselves or in

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the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id.*

As each of these claims depends from an independent claim including limitations not taught or suggested by any art of record, as described above, all claims distinguish over all art of record.

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 103 rejection with respect to these claims.

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PATENTCONCLUSION

For the reasons given above, the Applicant respectfully requests reconsideration and allowance of the pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at jmockler@munckbutrus.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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